



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of
Bergert, Thomas F.

Serial No.: 09/473,136

Filed: December 28, 1999

For: Recreational Outing
Reservation System

Examiner: Christopher L. Gilligan

Art Unit: 3626

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SUPPLEMENTAL REPLY BRIEF

in RESPONSE to SECOND EXAMINER'S ANSWER

Applicant has received the Examiner's Answer from Examiner Christopher L. Gilligan dated June 13, 2007 ("Ex. Gilligan Answer"), responding to Applicant's Appeal Brief filed December 9, 2004. Applicant received the identical Examiner's Answer from original Examiner Alexander G. Kalinowski dated March 9, 2005 ("Ex. Kalinowski Answer"), and subsequently submitted a Reply Brief on May 9, 2005 ("Applicant's Original Reply Brief"). Copies of the Ex. Kalinowski Answer, Applicant's Reply Brief, Applicant's Certificate of Transmission of the Reply Brief and date-stamped post card from the U.S. Patent Office acknowledging receipt of the Reply Brief are attached as Exhibit A.

As Applicant has already responded to the identical Examiner's Answer, Applicant hereby incorporates Applicant's Original Reply Brief (copy attached) into the present reply. Applicant further provides brief comments below in light of the recent U.S. Supreme Court ruling in *KSR International Co., v. Teleflex Inc. et al.*, 82 U.S.P.Q.2d 1385 (U.S. 2007) concerning obviousness.

The U.S. Supreme Court has recently ruled that an obviousness determination is not the result of applying a rigid formula such as the teaching, suggestion, motivation (TSM) test apart from the facts of the case. *KSR International Co., v. Teleflex Inc. et al.*, 82 U.S.P.Q.2d 1385 (U.S. 2007). Instead, the Supreme Court stated that the *Graham v. John Deere Co. of Kansas City*, 148 U.S.P.Q. 459 (U.S. 1966), factors still control an obviousness inquiry. Those factors are: 1) "the scope and content of the prior art"; 2) the "differences between the prior art and the claims"; 3) "the level of ordinary skill in the

pertinent art”; and 4) objective evidence of nonobviousness. *KSR*, 82 U.S.P.Q.2d at 1388 (quoting *Graham*).

Following the *Graham v. John Deere* and *KSR v. Teleflex* analyses, the differences between the claimed subject matter and the prior art references are outlined, for example, in the Argument Section of Applicant’s Appeal Brief and on pages 3-8 of Applicant’s Original Reply Brief. In the rejection of all of the presently pending claims under 35 U.S.C. § 103, the Examiners have applied a minimum four (4) references to each claim using the TSM test, with the primary reference applied in independent claims 1, 17 and 18 (the Davies reference) relating to a “Tee Phone” that allows a user to blindly submit a tee time preference for a single golf course through a telephone. The Examiner’s application of the additional references to be combined with the Davies Tee Phone follows a strained and tenuous path that does not make obvious the invention as claimed, whether under the TSM test *or* the *Graham v. John Deere* test. The differences noted on pages 3-8 of the Original Reply Brief specify why.

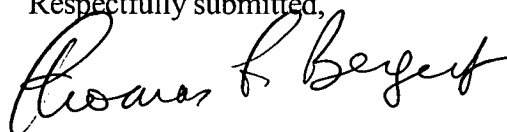
Applicant filed the present patent application on December 28, 1999, based on a provisional patent application filed on December 29, 1998, nearly a decade ago. These dates limit the art which can be applied to Applicant’s claims by law, and the prior art of record simply and clearly does not support an obviousness rejection for the reasons stated in Applicant’s Appeal Brief and Original Reply Brief. Applicant reiterates that a person of ordinary skill *at the time of Applicant’s invention nearly a decade ago*, would not have

found the claimed subject matter obvious in light of the Davies Tee Phone, the GolfAgent reference or any of the remaining prior art of record.

For these reasons and as stated in Applicant's Appeal Brief and Original Reply Brief, Applicant submits that the present rejection should be reversed and all claims allowed.

A change of correspondence address is being submitted simultaneously with this Supplemental Reply Brief.

Respectfully submitted,



THOMAS F. BERGERT
Applicant

Aug. 8, 2007

Attached: (1) Exhibit A

copy of the Ex. Kalinowski Answer
copy of Applicant's Original Reply Brief dated May 9, 2005
copy of Applicant's Certificate of Transmission of the Original
Reply Brief
copy of date-stamped post card from the U.S. Patent Office
acknowledging receipt of the Reply Brief

(2) Applicant's Change of Correspondence Address Form

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6429 Woodbourne Ln.
Crozet, VA 22932
Tel. No.: 703.627.9903

Exhibit A

To the Assistant Commissioner for Patents
Washington, D.C. 20231

Atty.: _____

Docket No.: _____

Date: May 9, 2005

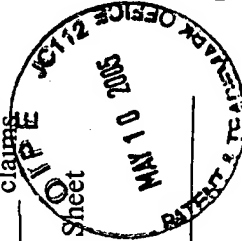
Title: RECREATIONAL OUTING RESERVATION SYSTEM

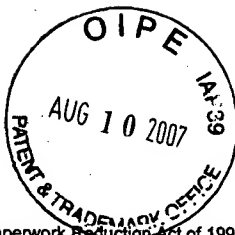
Serial No.: 09/473,136

Inventor(s): BERGERT, Thomas F

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Application Number

09/473,136

Filing Date

December 28, 1999

First Named Inventor

BERGERT, Thomas F.

Art Unit

3626

Examiner Name

A. Kalinowski

Attorney Docket Number

ENCLOSURES

(Check all that apply)

<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC
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Firm Name

Signature

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Thomas F. Bergert

Date

May 9, 2005

Reg. No.

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